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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,245	03/06/2000	Chaitanya Kanojia	2657.2001003	8263

21005 7590 05/07/2003

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EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/519,245

Applicant(s)

KANOJIA ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-7,9.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:



**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 1/28/2003.

***Claim Objections***

2. Claims 9 and 10 are objected to because of the following informalities:

  Claim 9 line 1, --a-- should be inserted after "in response to" for clarity.

  Claim 10 page 37 line 1, "from" should be replaced by --to-- for clarity.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-10, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (US6446261) in view of Khoo et al (US6434747). Rosser teaches methods of inserted downloaded advertisement material into a user's TV programming. The user's set top box monitors the users viewing behavior in order to develop a user profile. Ads are associated with required viewer profiles (group profiles) so as to target the ads to the appropriate users. Rosser stores the profiles locally. Khoo et al also teaches delivery of content over a data network and subsequent insertion of targeted ads to a TV viewer, based on the user profile. Khoo et al teaches the storage of the ad content

and profile in a remote server which is provided with media transport service module acting as a bulk transfer manager and agent to access and download the content to the various users [col 6 lines 55-58]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the profiles in a remote server as taught by Khoo et al. Regarding the instructions to download when and which content to download, Khoo et al teaches that the client devices are instructed to only download content which matches the user profile and customizes media list; the entire collection of available content is not sent to the user, but only a portion based on the profile/customized media list. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded only the customized content for each user, based on their profile, so that processing and resources are not burdened with downloading content that does not match the profile and will never be shown. The “when” limitation of the claim amendment can be met by instructions to download the content immediately (i.e. now).

The system of Rosser provides signaling to the set top box to insert the appropriate ad (system manager functionality). Rosser teaches activation criteria of turning on the TV, for example [col 4 lines 60-64].

Regarding claims 8 and 9, Rosser also teaches switching channels as an event for ad activation/display.

### ***Response to Arguments***

5. Applicant's arguments filed 1/28/03 have been fully considered but they are not persuasive. Applicant argues that Rosser downloads all content available and not customized content based on user profile (thus leading to bandwidth problems). Khoo et al however teaches *customized* content download to the client devices based on user profiles matching; Khoo et al does not download the entire collection of available content. The "when" limitation of the claim amendment can be met by instructions to download the content immediately (i.e. now).

Applicant also argues that Khoo et al does not teach a data network. Khoo et al indeed teaches a data network for delivery of customized content (230, fig 2).

Applicant argues that problems with bandwidth and concurrent client data requests are avoided. However, such arguments are narrower than the present claim scope.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc  
April 7, 2003